

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. SANDERS

Appeal No. 2000-0224
Application No. 29/081,424

ON BRIEF

Before McQUADE, OWENS, and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:¹

The ornamental design of an LIQUID AND SEDIMENT COLLECTOR as shown and described.

¹ While the copy of the appealed claim in the appendix to the appellant's brief is substantially correct, it does differ from the actual claim of record in that the use of capitalization in the claim of record has been omitted in the copy in the appendix and in that "an" in the record claim appears as "a" in the copy in the appendix.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Stokes	1,420,886	Jun. 27, 1922
Richards	3,139,628	Jul. 7, 1964

The following rejection stands before us for review.²

The appealed claim stands rejected under 35 U.S.C. § 103 as being unpatentable over the lift pipe 31 of Stokes in view of the pipe elbow piece 12 of Richards.

The examiner's rationale for the rejection appears on page 3 of the answer (Paper No. 10) and reads as follows:

The overall appearance of Appellant's claimed design is substantially disclosed by Stokes 31, except for a difference in the length and termination of the short extension.

Richards 12 shows a similar short length and termination on a pipe like that of the claimed design.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have fashioned the pipe of Stokes to have a short extension with a straight cut termination on one end of the elbow as taught by Richards. To do so would result in an appearance over which the claimed article bears no unobvious ornamental differences.

In response to this rejection, the appellant argues that neither Stokes nor Richards discloses a liquid and sediment collector having design characteristics that are basically the same

² The examiner's rejection of the claim under 35 U.S.C. § 171 as not meeting the requirements of ornamentality has been withdrawn (see advisory action, Paper No. 7) in view of the appellant's response and affidavit filed April 5, 1999 (Paper No. 6).

as the claimed design and that, thus, neither reference satisfies "the Rosen test." Further, the appellant argues that the pipes of Richards and Stokes are not so related that the appearance of certain ornamental features in one patent would suggest the application of those features to the other (brief, pages 5 and 6). Additionally, the appellant urges that, since the Richards pipe is not intended for use as a liquid and sediment collector, the modification of the Stokes pipe proposed by the examiner would not have been obvious to a designer of ordinary skill who designs liquid and sediment collectors and liquid traps (brief, pages 6 and 7).

We note, at the outset, that this design application illustrates four embodiments of the invention. The first embodiment, illustrated in Figures 1-6, is a pipe, open at both ends, comprising one relatively long leg and a significantly shorter leg, with the two legs being connected by a 90 degree bend. The radius of curvature of the inside curve of the bend appears to be approximately equal to the diameter of the pipe. The second, third and fourth embodiments, illustrated in Figures 7-12, 13-18 and 19-24, respectively, include the first and second leg connected by a 90 degree bend of the first embodiment and additionally include from one to three short segments extending perpendicularly outwardly from the longer leg in a direction parallel to the shorter leg. The ends of the additional short segments, which are open, lie in the same plane as the open end of the shorter leg. While it is true that multiple embodiments can be presented in a design application only if they involve a single inventive

concept³, the examiner (Paper No. 3, page 2) has determined that the above identified embodiments present overall appearances that are not distinct from one another and, thus, has not required a restriction of the application to one of the embodiments. While the appellant (Paper No. 4, page 2, and paragraph 2 of the Sanders declaration attached to Paper No. 4) refers to the four disclosed embodiments as being "visually distinct from each other," the appellant has not directly traversed this determination by the examiner or requested reconsideration thereof. Consequently, the appealed claim is broad in the sense that the unpatentability of any embodiment presented would defeat the claim.⁴ In reviewing the examiner's rejection of the claim under 35 U.S.C. § 103, we shall focus our attention on the embodiment of Figures 1-6, which most closely resembles the prior art pipes relied upon by the examiner.

Stokes illustrates two pipe sections, each identified by the reference numeral 31, connected by a fitting. These pipe sections serve as a liquid lifting pipe to deliver fuel from a main tank 30 to a fuel chamber 15 of a carburetor for an internal combustion engine. One of the pipe sections 31 runs from the "main tank" 30 to the connection fitting and the other pipe section 31 runs from the connection fitting to the "fuel chamber" 15. On page 2 of the final rejection (Paper No. 5), the examiner states that "only the L-shaped portion of the pipe that

³ In re Rubinfield, 270 F.2d 391, 396, 123 USPQ 210, 214 (CCPA 1959), cert. denied, 362 U.S. 903 (1960)

⁴ See Ex parte Appeal No. 315-40, 152 USPQ 71, 72 (Bd. App. 1965).

runs from the fuel tank to the connection fitting was intended by the examiner to be considered the primary reference to Stokes." While it is apparent from this statement that the examiner is relying on only one of the two pipe sections 31, given the examiner's use of terminology ("fuel tank") which differs from that used by Stokes ("main tank" and "fuel chamber") and the fact that both pipe sections comprise two straight legs and a bend to form an L-shaped portion, it is not clear to us which of the two sections 31 forms the basis of the examiner's rejection. Thus, we shall view each of the pipe sections independently to see if either forms a proper basis for the examiner's rejection under 35 U.S.C. § 103.

The test for determining obviousness of a claimed design under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Carter, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982) and In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). The appellant's design lies in the realm of designers of liquid and sediment collectors.

In order to support a holding of obviousness under 35 U.S.C. § 103, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references. See In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The examiner contends that Stokes does share similar characteristics with the claimed design, in that both the claimed design and the Stokes pipe are L-shaped pipes intended to transport liquids (answer, page 4). Even assuming that the design characteristics of either of the pipe sections 31 of Stokes are basically the same as the appellant's claimed design as contended by the examiner, we note that there are material differences between the appellant's design and either of the Stokes pipes which produce an overall appearance which would be recognized as different by an ordinary observer. In the appellant's design, the length of the shorter leg and the inside radius of curvature of the bend are each about the same as, or perhaps slightly larger than, the diameter of the pipe and the longer leg is significantly longer (at least about 10 times) than the diameter of the pipe. Turning first to the Stokes pipe section 31 running between the connection fitting and the fuel chamber 15, the shorter (vertical) leg has a length which is noticeably larger than the pipe diameter, while the bend is so sharp that its radius of curvature is almost imperceptible, giving an impression very close to a corner rather than a curved bend. The pipe section 31 running between the main tank 30 and the connection fitting has a (possibly shorter) horizontal leg whose length, even foreshortened as illustrated, is noticeably more than several times the pipe diameter, as distinguished from the shorter leg of the appellant's design. Additionally, unlike the smooth ends of the appellant's design, the right-hand end of each of the pipe sections 31 of Stokes is threaded. The examiner's rejection, as discussed above, relies on the elbow piece 12 in Richards' automatic swimming pool water

refill system for a suggestion to provide a short extension with a straight cut termination on the pipe of Stokes.

As regards the combination of references in design cases, the question is not whether the references sought to be combined are in analogous arts in the mechanical sense, but whether they are so related that the appearance of certain ornamental features in one would suggest the application of those features to the other. Thus, if the problem is merely one of giving an attractive appearance to a surface, it is immaterial whether the surface in question is that of wall paper, an oven door, or a piece of crockery. On the other hand, when the proposed combination of references involves material modifications of the basic form of one article in view of the other, the nature of the articles involved is a definite factor in determining whether the proposed change involves invention. The art from which a patent is drawn does not necessarily preclude its citation as a reference but "it does reflect on the question of remoteness of suggestion between what it discloses and what the applicant discloses." In re Glavas, 230 F.2d 447, 450-451, 109 USPQ 50, 52-53 (CCPA 1956).

In this instance, while we recognize that the elbow piece 12 of Richards, like both of the pipes 31 of Stokes and the appellant's design, is an L-shaped pipe having one longer leg and a shorter leg connected by a curved bend portion, we find ourselves in agreement with the appellant that the elbow piece 12 of Richards' automatic swimming pool water refill system is not so related to the fuel lifting pipes of Stokes as to have suggested modification of either of

the pipes 31 of Stokes to provide a straight cut termination (i.e., elimination of the threads) and short extension of the shorter leg as proposed by the examiner.

Therefore, we cannot sustain the examiner's rejection of the appealed design claim.

CONCLUSION

To summarize, the decision of the examiner to reject the design claim under 35 U.S.C.
§ 103 is reversed.

REVERSED

JOHN P. McQUADE
Administrative Patent Judge

TERRY J. OWENS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2000-0224
Application No. 29/081,424

Page 10

Burd Bartz & Gutenkauf
Richard O. Bartz
1300 Foshay Tower
Minneapolis, MN 55402